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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,710	01/11/2001	Katsuhiko Oki	001765	4391

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ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP
1725 K STREET, NW
SUITE 1000
WASHINGTON, DC 20006

EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/754,710

Applicant(s)

OKI ET AL.

Examiner

Robert M. Pond

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply:

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 26-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Applicant is claiming program information stored on recordable medium. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of

data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir.1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a

computer-readable medium does not make it statutory. Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) (“[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.”) (quoted with approval in Abele, 684 F.2d at 907, 214 USPQ at 687). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) (“form of the claim is often an exercise in drafting”). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

Claims to processes that do nothing more than solve mathematical problems or manipulate abstract ideas or concepts are more complex to analyze and are addressed below. If the “acts” of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. Schrader, 22 F.3d at 294-95, 30 USPQ2d at 1458-59. Thus, a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 3, 10, 11, and 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Regarding Claims 1, 11, and 26, the phrase "or similar items" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or similar items"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).
- Regarding Claim 3, the phrase "repeating all remaining parts of Claim 2, in the event said new information is sent to said second device," renders the claim indefinite because the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. *Ex Parte Hasche*, 86 USPQ 481.
- Regarding Claim 10, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-9 are rejected under 35 USC 102(b) as being anticipated by Rosen (patent number 5,621,797).

Rosen teaches all the limitations of Claims 1-9. For example, Rosen discloses a method of selling electronic tickets (e.g. event tickets, electronic merchandise) and transferring an electronic ticket purchased by a first buyer (first device) across an electronic communications link (please note this discloses send and receiving first information) from a seller's device (second device), a human-to-machine interface capable of displaying electronic ticket information (e.g. keyboard, mouse, pen voice, touch screen, icons, menus), and use of wireless transaction devices (see at least title; abstract; Fig. 1 (1, 4); Fig. 3 (122, 132); Fig. 5 (188, 198); col. 1, lines 15 through col. 2, lines 43; col. 4, line 45 through col. 28; col. 8, lines 21-29). Rosen discloses a buyer (first device) making payment in exchange for an electronic ticket using at least a credit card or debit card account to be charged, and seller's device (second device) forming a communication link with a trusted agency (third device) for account charging (sending second information), and engaging in abort and commit communication depending on whether the purchase transaction could be completed or not

completed (third information) and rectifying ownership of the electronic ticket, and repeating attempts to complete transactions (see at least Fig. 1 (MONEY); Fig. 5 (192, 208); col. 10, lines 15-38; col. 23, lines 26-67; col. 13, lines 52 through col. 15, lines 27; col. 24, lines 37-64). Rosen discloses transferring an electronic ticket aside from the initial issuing of a ticket, purchasing a ticket via a desktop transaction device embedded in a personal computer and transferring it to a portable device, an owner transferring credentials from one device to another device, and an owner purchasing a ticket (first device) and transferring the ticket to another party's device (fourth device) (see at least col. 26, lines 12-24). Rosen discloses the transfer mechanisms ensuring ownership is transferred from previous owner to current owner and that the ticket has been erased from previous owner's device, and communicating change in ownership credentials (see at least col. 13, lines 62-66; col. 26, lines 25-56).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 10 is rejected under 35 USC 103(a) as being unpatentable over Rosen (patent number 5,621,797), in view of Ohr (PTO-892, Item: U).**

Rosen teaches all the above as noted under the 102(b) rejection and further teaches wireless transaction devices connecting into a network (see at least col. 8, lines 21-29), but does not disclose Bluetooth. Ohr teaches Bluetooth technology as a springboard for wireless Internet access for wireless devices (cellular phones) (Item: U, see at least pages 1-2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Rosen to include Bluetooth as taught by Ohr, in order to allow users to benefit from evolving technology providing wireless access to the Internet, and thereby attract wireless commerce users to the service.

6. Claims 11-18 are rejected under 35 USC 103(a) as being unpatentable over Rosen (patent number 5,621,797), in view of Revett et al. (PTO-892, Item: V).

Rosen teaches an open electronic commerce system comprising servers connected over a network, wireless or wired transaction devices interfacing with network servers, and storing information. Rosen teaches selling electronic tickets (e.g. event tickets, electronic merchandise) and transferring an electronic ticket(s) purchased by a first buyer (first device) across an electronic communications link (please note this discloses send and receiving first information) from a seller's device (second device), a human-to-machine interface capable of displaying electronic ticket information (e.g. keyboard, mouse, pen voice, touch screen, icons, menus), and use of wireless transaction

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devices (see at least title; abstract; Fig. 1 (1, 4); Fig. 3 (122, 132); Fig. 5 (188, 198); col. 1, lines 15 through col. 2, lines 43; col. 4, line 45 through col. 28; col. 8, lines 21-29). Rosen teaches a buyer (first device) making payment in exchange for an electronic ticket using at least a credit card or debit card account to be charged, and seller's device (second device) forming a communication link with a trusted agency (third device) for account charging (sending second information), and engaging in abort and commit communication depending on whether the purchase transaction could be completed or not completed (third information) and rectifying ownership of the electronic ticket, and repeating attempts to complete transactions (see at least Fig. 1 (MONEY); Fig. 5 (192, 208); col. 10, lines 15-38; col. 23, lines 26-67; col. 13, lines 52 through col. 15, lines 27; col. 24, lines 37-64). Rosen teaches transferring an electronic ticket aside from the initial issuing of a ticket, purchasing a ticket via a desktop transaction device embedded in a personal computer and transferring it to a portable device, an owner transferring credentials from one device to another device, and an owner purchasing a ticket (first device) and transferring the ticket to another party's device (fourth device) (see at least col. 26, lines 12-24). Rosen teaches the transfer mechanisms ensuring ownership is transferred from previous owner to current owner and that the ticket has been erased from previous owner's device, and communicating change in ownership credentials (see at least col. 13, lines 62-66; col. 26, lines 25-56).

Rosen teaches all the above as noted under the 103(a) rejection and teaches an open electronic commerce system comprising electronic servers, wireless or wired transaction devices, and users purchasing theater tickets, but does not specifically disclose a server providing a web site. Revett et al. teach users using wired or wireless devices, purchasing theater tickets using an electronic transaction device, and accessing web sites with transaction devices for electronic commerce shopping (see at least pages 1-3, and 7). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system of Rosen to disclose a server providing a web site as taught by Revett et al., in order to allow users to access web-based commerce shopping services, and thereby capture a growing source of shoppers using wireless devices.

- 7. Claims 19-25 are rejected under 35 USC 103(a) as being unpatentable over Rosen (patent number 5,621,797) and Revett et al. (PTO-892, Item: V), as applied to Claims 11 and 14, in view of Mann et al. (patent number 6,119,096).**

Rosen and Revett et al. teach all the above as noted under the 103(a) rejection and further teach biometrics as a means to identify a user (see at least col. 11, lines 40-43), but do not disclose fingerprinting. Mann et al. teach buyers purchasing tickets for entertainment and sporting events, aftermarket resale of tickets by a reseller (see at least abstract; col. 1, lines 47 through col. 2, line 2).

Mann et al. teach biometric scanning, fingerprinting, palm printing, facial scanning, or iris scanning to authenticate a user (see at least col. 5, lines 3-17), storing images in databases, and accessing financial networks (see at least Fig. 1 (106, 110, 111); col. 5, lines 18-45). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system of Rosen and Revett et al. to implement fingerprinting as taught by Mann et al., in order to authenticate a user.

8. Claims 26-37 are rejected under 35 USC 103(a) as being unpatentable over Rosen (patent number 5,621,797).

Rosen teaches a method of selling electronic tickets (e.g. event tickets, electronic merchandise) and transferring an electronic ticket purchased by a first buyer (first device) across an electronic communications link (please note this discloses send and receiving first information) from a seller's device (second device), a human-to-machine interface capable of displaying electronic ticket information (e.g. keyboard, mouse, pen voice, touch screen, icons, menus), and use of wireless transaction devices (see at least title; abstract; Fig. 1 (1, 4); Fig. 3 (122, 132); Fig. 5 (188, 198); col. 1, lines 15 through col. 2, lines 43; col. 4, line 45 through col. 28; col. 8, lines 21-29). Rosen teaches a buyer (first device) making payment in exchange for an electronic ticket using at least a credit card or debit card account to be charged, and seller's device (second device) forming a communication link with a trusted agency (third device) for account charging

(sending second information), and engaging in abort and commit communication depending on whether the purchase transaction could be completed or not completed (third information) and rectifying ownership of the electronic ticket, and repeating attempts to complete transactions (see at least Fig. 1 (MONEY); Fig. 5 (192, 208); col. 10, lines 15-38; col. 23, lines 26-67; col. 13, lines 52 through col. 15, lines 27; col. 24, lines 37-64). Rosen teaches transferring an electronic ticket aside from the initial issuing of a ticket, purchasing a ticket via a desktop transaction device embedded in a personal computer and transferring it to a portable device, an owner transferring credentials from one device to another device, and an owner purchasing a ticket (first device) and transferring the ticket to another party's device (fourth device) (see at least col. 26, lines 12-24). Rosen teaches the transfer mechanisms ensuring ownership is transferred from previous owner to current owner and that the ticket has been erased from previous owner's device, and communicating change in ownership credentials (see at least col. 13, lines 62-66; col. 26, lines 25-56).

Rosen teaches all the above as noted under the 103(a) rejection and further teach use of hardware and computer software, but do not disclose recordable medium storing computer software. It would have been obvious to one of ordinary skill in the art at time of the invention to disclose recordable medium for program software storage, since it is well within the skill to ascertain that computer software executed by a computers is stored in recordable medium.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Vincent Millin** can be reached on 703-308-1065.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

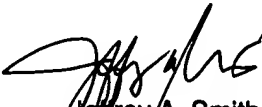
Washington D.C. 20231

or faxed to:

703-872-9306 (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

RMP
February 9, 2004


Jeffrey A. Smith
Primary Examiner